UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,341	09/04/2001	Tsuneo Sato	0649-0799P	9771

2292   7590   08/12/2009
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EXAMINER
RICHER, AARON M

ART UNIT	PAPER NUMBER
2628	

NOTIFICATION DATE	DELIVERY MODE
08/12/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<table>
<tr>
<td rowspan="2">Advisory Action
Before the Filing of an Appeal Brief</td>
<td colspan="2">Application No.
09/944,341</td>
<td colspan="2">Applicant(s)
SATO ET AL.</td>
</tr>
<tr>
<td colspan="2">Examiner
AARON M. RICHER</td>
<td>Art Unit
2628</td>
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</table>

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>28 July 2009</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

  a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

  b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

    Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

  (a)☒ They raise new issues that would require further consideration and/or search (see NOTE below);

  (b)☐ They raise the issue of new matter (see NOTE below);

  (c)☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

  (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

    NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

  The status of the claim(s) is (or will be) as follows:

  Claim(s) allowed: _____.

  Claim(s) objected to: _____.

  Claim(s) rejected: _____.

  Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Aaron M Richer/
Examiner, Art Unit 2628

Continuation of 3. NOTE: The cancellation of claims 9 and 10 and amendment of claims 11-14 to depend on claim 17 requires further consideration to see if the claims as amended comply with 35 USC 112. The claims do not put the application in better form for appeal because the current rejections do not take into account the new dependencies. For instance, the rejection of claims 11-14 would have to be changed to incorporate the PNG Specification reference.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the "apparatus" of claim 17 is not software because the "means" in figure 12 are not labeled with "s/w" as the software in fig. 8 and 9 is. However, using two different terms to refer to software is not something that is uncommon in the art. Since the means of fig. 12 do not appear to have any hardware support, and the software for table development could be loaded into a software "table development means", examiner must assume that they both correspond to software. Applicant further argues that the apparatus is not software because the specification discloses that the color management apparatus may be utilized in various known machines. Examiner notes that this does not in any way qualify the apparatus as hardware. A software apparatus could still be utilized in many different known machines. Finally, applicant argues that the claimed apparatus cannot be merely achieved with software and requires some sort of circuitry to function. Examiner agrees that hardware is required for software to function, but this statement does not address where in the claim this hardware can be found.

As to claim 16, applicant argues that the method of claim 16 transforms input image data into output image data, and that both supplied image data and output data represent a physical image or article that can be reproduced. Examiner notes that "data" is by definition, not a physical article, but rather a construct within a computer memory. The fact that a data signal may represent an actual image is irrelevant because the actual image "article" is not in the claim. Even if the image were claimed as an actual article, such as a photograph, the claim still does not transform the article itself. Rather data would be read from the article and then a new article would be produced. Nothing would be transformed to a different state or thing. Perhaps more importantly, even if the claim explicitly recited producing an actual new article, such as a new image on a piece of paper, the Bilski decision clearly states that insignificant extra-solution activity will not render a claim statutory under 35 USC 101. The claim's "solution" relates to the lookup table development process, and so at least one of the significant steps in that process should be tied to a machine to render the claim statutory under 35 USC 101.

As to the 35 USC 112 rejection of claim 17, applicant argues that the structure corresponding to the means-plus-function language is implicit in the specification. Examiner disagrees, noting that the table development means can be anything that develops a table. The means in this case are not implicitly a computer or a specific part of a computer. Rather the means are a "black box" that perform a function of table development and there is no disclosure of what kind of structure would be used to develop such a table. The means in this case can be anything from a piece of software to a dedicated system of logic gates. Recent court decisions, such as Blackboard v. Desire2Learn (Fed. Cir. 2009) , affirm that such a black box in a block diagram is not a sufficient showing of structure for a means-plus-function limitation.

As to the 35 USC 103 rejection of claim 17, applicant argues that the cited combination does not include an identifier for identifying a table development method and a lookup table composed of characteristic points. Applicant does not further explain why the combination of the Bhattacharjya table and the Goldstein memory storing breakpoints does not read on the claimed identifier and table. Examiner notes that the Bhattacharjya reference includes a table of points impossible to be linearly interpolated, as stated in the rejection. Bhattacharjya lacks an actual determination step that identifies a particular interpolation method and determines which points must be saved for that particular method. The Goldstein reference has been brought in to show that identifying a particular interpolation method and then determining which points are impossible to be interpolated is known in the art. In particular, Goldstein discloses that the interpolation method is identified as linear interpolation and determines breakpoints that cannot be correctly interpolated by a linear interpolation algorithm (col. 5, lines 32-55; col. 6, lines 10-17).